

Appl. No. : 10/616,160  
Filed : July 9, 2003

## REMARKS

### Application status

Applicant requests clarification on the status of the present application.

While the cover sheet mailed with the Office Action of January 24<sup>th</sup> indicates that the Office Action is final, the body of the Office Action itself does not indicate that it is a final Office Action. Furthermore, the Office Action sets forth a new ground of rejection. Accordingly, Applicant respectfully requests clarification that the Office Action mailed on January 24, 2005 is a non-final Office Action. Alternatively, if the Office Action of January 24, 2005 is deemed to be a Final Office Action, Applicant respectfully requests withdrawal of the Finality of the Office Action of January 24, 2005 in view of the new ground of rejection applied in that Office Action.

### Rejection under 35 U.S.C. § 102(b)

Claims 1-4 are rejected under 35 U.S.C. § 102(b) as being anticipated by Bryning et al. (U.S. 6,296,702).

The Examiner asserts that the method of Bryning, et al. would produce spots of at least 1 mm in view of the teaching of Bryning, et al. that the “operation is effective, for example to dispense a selected volume preferably less than about 1  $\mu$ l.” (col. 9, lines 60-64, cited by the Examiner).

While there is some overlap in the amount dispensed by Bryning, et al. and the sample volume recited in Applicant’s dependent claims 3-4, Applicant maintains that the spotting device and method taught by Bryning, et al. would not produce spots of “at least 1 mm” in size as claimed by Applicant (claim 1).

The goal of the ‘702 invention is to produce small spots, not the larger spots for ease of visualization taught in the present application. In order to produce smaller spots, the patent teaches an apparatus having a fiber within a tube with a diameter of less than 1 mm, preferably less than 500  $\mu$ m and more preferably less than 200  $\mu$ m. The diameter of the fiber is less than the diameter of the tube, about 10-100  $\mu$ m smaller than the tube (col. 2, lines 20-29). Thus, the diameter of the fiber is, at most, 990  $\mu$ m and more likely much smaller in order to deliver the

Appl. No. : 10/616,160  
Filed : July 9, 2003

small spots which is the goal of Bryning, et al. Accordingly, the device and method taught by Bryning, et al. could not produce a spot of at least 1 mm as recited in Applicants' claim 1.

Furthermore, claim 1 specifically recites the use of a micropipette, while the teaching of Bryning, et al. is directed to the use of a fiber to dispense a small volume as discussed above. The '702 patent does not teach dispensing a sample from a micropipette to produce a spot with a diameter of at least 1 mm as set forth in Applicant's claim 1. Thus, the '702 patent of Bryning, et al. does not teach all of the elements of the claimed invention.

In fact, the '702 patent actually teaches away from using a micropipette in the Background of the Invention section which states that "micropipettes are generally incapable of accurately dispensing the extremely small volumes of liquid called for by many present-day protocols" (col. 1, lines 46-49). Instead, the '702 patent teaches the use of a fiber in order to form small invisible spots. Accordingly, the '702 patent does not teach a micropipette as claimed and in fact teaches away from using a micropipette.

Furthermore, the presently claimed invention is directed to providing an array which is easily visualized while the '702 patent is directed to providing a microarray with small spots. One of ordinary skill in the art would not be motivated to follow the teaching of the '702 patent because the microarrays of the '702 patent could not be easily visualized which is the goal of the presently claimed invention. Accordingly, Applicant submits that the present claims are patentable over Bryning, et al.

In view of Applicant's arguments, reconsideration and withdrawal of the above ground of rejection is respectfully requested.

### **CONCLUSION**

In view of the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Appl. No. : 10/616,160  
Filed : July 9, 2003

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: April 20, 2005

By: Che S. Chereskin  
Che Swyden Chereskin, Ph.D.  
Registration No. 41,466  
Agent of Record  
Customer No. 20,995  
(949) 760-0404

1675207  
042005